

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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*J.S.*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/945,574 02/27/98 LENTING H H-1920-PCT/U

IM62/0625

EXAMINER

GLENN E J MURPHY  
HENKEL CORP  
140 GERMANTOWN PIKE  
SUITE 150  
PLYMOUTH MEETING PA 19462

FRIES, K

ART UNIT	PAPER NUMBER
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1751

DATE MAILED:

06/25/99

*8*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.  
09/945,574

Applicant(s)

Larry S  
Bernaldo et al

Examiner

Fr. S

Group Art Unit  
1751

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

Responsive to communication(s) filed on 2-27-92

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

### Disposition of Claims

Claim(s) 14-34 is/are pending in the application.

Of the above claim(s) 14, 17, 20-28, 30 is/are withdrawn from consideration.

Claim(s) 15-16, 18-19, 29, 31-34 is/are allowed.

Claim(s)  is/are rejected.

Claim(s)  is/are objected to.

Claim(s)  are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been  received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

### Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). 1-9-92  Interview Summary, PTO-413

Notice of References Cited, PTO-892  Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

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### **DETAILED ACTION**

This Office action is the first by the Patent Office concerning the patentability of Applicants' invention. Initially, claims 1-12 were pending in the application. In a first preliminary amendment, applicants canceled claims 2-13. In a second preliminary amendment, applicants canceled claim 1 and added new claims 14-34 have been added. Currently, claim 14-34 are pending in the application. The applicants claim priority to PCT application EP 96/01755 and claim foreign priority to EP application 9520115.3.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (c) he has abandoned the invention.
- (d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 14,17,20-28,30 are directed to the same invention as that of claims 2-5 of Patent number 8,556,165 filed Jan 5, 1999 and have the same foreign priority document EP 95201115.

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The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of which has the same foreign priority document, the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application. The examiner notes for the record the following: Application presently pending is by Henkel corporation and patent number 5,856,165 is to Genencor international. The applicants want to know if such patent has been assigned to applicants. If such is not assigned to applicants, then in the next Office action, the examiner may request a copying of the claims.

Claims 14, 17,20-28, and 30 are directed to an invention not patentably distinct from claims 2-5 of patent 5,856,165 which has the same foreign priority document . Specifically, the claims are not distinct because both patents claim a composition which has as its only element a cellulase enzyme from CBS 670.93.

Common priority document 952011155 , discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this

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issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g).

The examiner is trying to clarify this application. The examiner notes that as the cases are not commonly assigned at the present time. However, this is to request that applicants clarify the record. The examiner is confused as to what is presently being owned by whom. If applicants respond that the record is correct that the claims are not commonly assigned, then the examiner will withdraw these but may incorporate a request to copy claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kery Fries whose telephone number is (703) 308-0687. The examiner can normally be reached on Monday through Thursday from 6:30 to 4:00 Pm. The examiner can also be reached on alternate Fridays

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661. **The examiner request that Applicant's representative phone the examiner and discuss this application. The examiner is confused as to how two separate entities could have the same foreign priority document. If examiner is overlooking something please explain.**

Kery Fries

June 21, 1999

  
Kery Fries  
Primary Examiner